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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,903	04/01/2005	Minoru Wada	268849US3PCT	5289

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EXAMINER	
NORDMEYER, PATRICIA L	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/529,903	WADA ET AL.	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-5 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 01 April 2005 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 4/05 & 6/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on April 1, 2005 and June 30, 2005 are being considered by the examiner.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 7 and 8 of copending Application No. 10/271,788. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are claiming adhesive roll cleaners

that use helically wound adhesive tapes with the adhesive portion having tear strengths of 500mN or greater.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3 and 5 are directed to an invention not patentably distinct from claims 1 and 5 - 8 of commonly assigned 10/271,788. Specifically, because both applications are claiming adhesive roll cleaners that use helically wound adhesive tapes with the adhesive portion having tear strengths of 500mN or greater.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 10/271,788, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly

assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riboud (USPN 3,417,418) in view of Wood (USPN 5,763,038).

Riboud discloses an adhesive roll cleaner (Figures 1 – 5; Column 1, lines 23 – 24) comprising a core tube (Column 2, lines 55 – 56) and a plurality of adhesive tapes (Column 2, lines 8 – 14), each of the adhesive tapes having an adhesive applied to one side there to form an adhesive portion (Column 2, lines 1 – 5), each of the adhesive tapes being helically wound (Column 2, lines 8 – 11, wherein spirally is the same as helically) around the core tube in a layered configuration with the adhesive portion out (Column 2, lines 1 – 5) and each of the adhesive tapes being would with a gap of prescribed with between every adjacent turn (Column 2, lines 13 – 14) as in claim 1. However, Riboud fails to teach the adhesive tape which is located at the upper layer having a larger width than that of the adhesive tape which is located at the lower layer, the width of the adhesive tapes increases stepwise toward the upper layer and the

adhesive tapes each have a non-adhesive portion with no adhesive applied on both longitudinal sides of the adhesive tape.

Wood teaches an adhesive tape which is located at the upper layer having a larger width than that of the adhesive tape which is located at the lower layer (Column 1, lines 53 – 56), the width of the adhesive tapes increases stepwise toward the upper layer (Column 3, line 55 to Column 4, line 12) and the adhesive tapes each have a non-adhesive portion with no adhesive applied on both longitudinal sides of the adhesive tape (Column 2, lines 23 – 29) as part of a lint removal tape (Column 4, line 63) for the purpose of having an outermost sheet that covers the perforations of the underneath layers which reduces instances of the tape tearing in a downweb direction (Column 1, lines 59 – 63).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the a upper layer having an increasing larger width the lower adhesive tape and the adhesive tape having non-adhesive portions in Riboud in order to have an outermost sheet that covers the perforations of the underneath layers which reduces instances of the tape tearing in a downweb direction as taught by Wood.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riboud (USPN 3,417,418) in view of Wood (USPN 5,763,038) as applied to claims 1 – 3 above, and further in view of Shizuno et al. (US PGPub 2003/0088928).

Riboud, as modified with Wood, discloses an adhesive roll cleaner comprising a core tube and a plurality of adhesive tapes, each of the adhesive tapes having an adhesive applied to one side there to form an adhesive portion, each of the adhesive tapes being helically wound around the core tube in a layered configuration with the adhesive portion out, each of the adhesive tapes being would with a gap of prescribed with between every adjacent turn and the adhesive tape which is located at the upper layer having a larger width than that of the adhesive tape which is located at the lower layer. However, the modified Riboud fails to teach the gap being between a width of 0.1 to 4.0 mm and the adhesive tapes each have a tear strength of 500 mN or greater as measured with an Elmendorf tear test in accordance with JIS P8116.

Shizuno et al. teach an adhesive roll cleaner that has a gap being between a width of 0.1 to 4.0 mm (Page 2, Paragraph 0018) and the adhesive tapes each have a tear strength of 500 mN or greater as measured with an Elmendorf tear test in accordance with JIS P8116 (Page 2, Paragraph 0021) for the purpose of preventing tearing of the adhesive sheet due to clinging debris (Page 2, Paragraph 0024).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the gap and tear strength in the modified Riboud in order to prevent tearing of the adhesive sheet due to clinging debris as taught by Shizuno et al.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 3,342,325 to Dreher and U.S. Patent No. 3,343,194 to Ramelson are cited to show the state of the art with regard to the spiral wound adhesive sheets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln